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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,462	01/31/2001	Bernhard Ifflander	01 P 7441 US	3441

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,462

Applicant(s)

IFFLANDER ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-17,19-30,32-41,43-46 and 48-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-17,19-30,32-41,43-46 and 48-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 11 January 2005 have been fully considered but they are not persuasive. The arguments are addressed by revision of the last rejection and expressly at para. 3 and 13 below. The possibility of allowable matter is discussed in para. 19-21 below.

Claim Objections

2. Claims 5-14 and 19-21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims add only nonfunctional descriptive matter. The nature of the services does not exhibit any functional interrelationship with the way in which the computing process is performed. See MPEP 2106.IV.B.1(b), first paragraph.
3. Applicant amended the subject claims, in part by limiting "plurality of services" to -- relocation services --, and replacing "comprises" with -- include --. These amendments fail to satisfy the objection, because they do not further limit the technological properties of the invention. By contrast, claim 15 is an example of a claim that adds a technological limitation, "transmitting" to the user.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At lines 1-2, "The method of claim 1, services are selected ..." is indefinite. (The conjunction "wherein" appears to be missing before "services").

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5-17, 19-30, 32-41, 43-46 and 48-57 are rejected under 35 U.S.C. 103(a) as obvious over Conhaim in view of *Thomasregister.com*.
8. Conhaim teaches (independent claims 1, 27, 30, 36, 40, 43, 46, 52, 56 and 57) an on-line method and system for marketing services to a prospective or actual purchaser of industrial equipment, the method comprising the steps of: providing to the purchaser over a network information relating to an on-line marketplace for industrial equipment (p. 1/8, middle); accepting over a network and storing in a database registration information from the purchaser (p. 3/8, third para.); displaying over the network in conjunction with the on-line marketplace an identification of a services relating to the purchasing, which reads on acquisition, of industrial equipment (p. 2/8 bottom); accepting over the network input from the purchaser identifying at least one of the plurality of services as to/for¹ which the purchaser wishes to receive information, and transmitting to the purchaser information relating to the at least one service (p. 2-3/8).
9. Conhaim does not teach displaying over the network an identification of relocation services relating to the purchase of industrial equipment. Because Conhaim teaches that Thomas Publishing specializes in both "industrial manufacturing products" and "travel/transportation" (p. 2.8, third para.), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Conhaim the transportation of said industrial manufacturing products, which reads on relocation services relating to the purchase of industrial equipment.

¹ The claim language "as to which" is interpreted as "for which".

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10. Conhaim does not teach accepting from the purchaser information relating to the nature of the equipment as to/for which service information is to be received, and transmitting said information to the at least one service provider. *Thomasregister.com* teaches an email connection for accepting from the purchaser information relating to the nature of the equipment as to/for¹ which service information is to be received, and transmitting said information to the at least one service provider (Item marked "A" on sheet 4/7). Because *Thomasregister.com* is the website taught by Conhaim, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of *Thomasregister.com* to those of Conhaim.
11. For independent claims 30 and 46, a "purchaser service request record" is interpreted as the purchase spec. that is necessarily input by the purchaser.
12. *Thomasregister.com* also teaches (independent claims 36, 43, 52, 56 and 57, and dependent claims 28 and 44) a user ID and password (Item marked "C" on sheet 6/7), which reads on assigning/transmitting a purchaser identification/registration code to the registered purchaser.
13. Applicant argues (p. 18 second para.) that the references do not teach coordination of various services. That is correct, but moot since coordination of various services is not claimed.
14. Conhaim also teaches claims 16-17, 32 and 48 at the citations given above; and claims 4-6 (p. 1/8 center and bottom).
15. *Thomasregister.com* also teaches (claims 15, 22-26, 29, 35, 37-39, 41, 45, 51 and 53-55) the purchaser requesting an offer (the "Order Online" Item marked "B" on sheet 5/7), the price of which reads on "information relating to the marketplace comprising data reflecting actual transactions in the marketplace".
16. Neither reference teaches (claims 7-14) the services offered. All of the services were widely advertised at the time of the instant invention.² Because Conhaim teaches that the reference online marketing site is advertiser-supported with a specialty in transportation

² Official notice of this common knowledge or well known in the art statement was taken in the last Office action (mailed 14 October 2004, para. 14). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

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services (p. 2/8 para. 1 and 3), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the claimed services to the teachings of Conhaim and *Thomasregister.com*.

17. Neither reference teaches (claims 19-21) the input equipment properties. Because these are obvious equipment descriptors, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these equipment descriptors to the teachings of Conhaim and *Thomasregister.com*.
18. Neither reference teaches (claims 33-34 and 49-50) determining and verifying that the purchaser has received the responsive information. Because it is good customer service, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add determining and verifying that the purchaser has received the responsive information to the teachings of Conhaim and *Thomasregister.com*.

Possibility of Allowable Subject Matter

19. Para. [0002] and [0003] of the published specification contain limitations that are not taught or suggested by the prior art made of record. Indeed, the examiner has search the *present* Thomas Publishing website, <http://www.thomasnet.com/>, and has heretofore been unable to find firms thereon that offer, for example, to coordinate the financing and relocation of large pieces of capital equipment offered for sale by an entity that is not a dealer in such goods. Hence there might be a basis for patentability if the claims were further limited with material from para. [0002] and [0003] of the published specification. It should be noted that the website cited in the last sentence does provide links to many firms, such as General Electric Company, which offer many industrial equipment services, including financing. Whether or not any of these firms did in fact offer further-limited claimed services at the time of the instant invention could only be determined by thoroughly searching any new amendment.
20. Applicant should also be aware that all of the material in para. [0002] and [0003] does not, by itself, confer patentable distinctions. For example, "coordinating" the financing and relocation of large pieces of capital equipment is not generally a technological limitation, so it would not, by itself, make claims patentable. However, if claims were limited to some sort of computerized coordination, they might be patentable. Similarly, adding that the capital equipment is offered for sale by an entity that is not a dealer in such goods would not, by

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itself, make claims patentable, but adding a limitation to "providing hyperlinks to institutions that have expressed an interest in financing the relocation of equipment offered for sale by an entity that is not a dealer in such goods" is a technological limitation, and, might therefore confer patentability. Some patentable limitations do not appear to be fully supported by the specification, and would therefore require a CIP application.

21. Should applicant be interested in having the instant invention examiner further, applicant is invited to send to contact the examiner for informal review of one or more proposed amendments of claim 1. The examiner would be pleased to evaluate said proposed claim(s) for patentability in terms of 35 USC 101 and 102. Note, however, that the examiner will not search said claim(s) after final; an RCE or CIP would have to be filed to enable that.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

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25. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.³ The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
27. **AFTER FINAL PRACTICE** – The examiner has made a specific order of after-final review in para. 21 above. Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant any other interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
28. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

26 March 2005

³ 571-272-6724 after the middle of April, 2005.